

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Dolph**

Serial No.: **10/803,631**

Filed: **March 18, 2004**

For: **Targeted Marketing Overlays for  
Digital Video Recorders**

§ Group Art Unit: **2621**

§

§ Examiner: **Tekle, Daniel T.**

§

§ Confirmation No.: **5810**

§

§ Attorney Docket No.: **AUS920040046US1**

**35525**

PATENT TRADEMARK OFFICE  
CUSTOMER NUMBER

Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

**RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF**

Sir:

A Notice of Non-Compliant Appeal Brief was received by Appellant stating that the Non-Compliant Appeal Brief filed on October 7, 2008 is considered non-compliant allegedly because the Appeal Brief does not contain the items required under 37 CFR 41.37(c) or the items are not under the proper heading or in the proper order and the Appeal Brief was not signed.

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

## **REMARKS**

In the Notification of Non-Compliant Appeal Brief, the Response to Non-Compliant Appeal Brief filed on October 7, 2008, was held defective allegedly because the Brief did not contain the items required under 37 CFR 41.37(c) or the items are not under the proper heading or in the proper order. Although not stated specifically, Appellant's understanding of the non-compliance was that section IX, Evidence Appendix, and section X, Related Proceedings Appendix, appeared before the signature block and also appeared again after the signature block. Appellant has corrected the deficiency. In addition to the foregoing, and additional deficiency was noted in that the brief was not signed. Appellant has corrected the deficiency.

It is respectfully submitted that the Response to Non-Compliant Appeal Brief filed herewith is in compliance with 37 C.F.R. § 41.37. Appellant respectfully requests that the Response to Non-Compliant Appeal Brief be entered.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: November 17, 2008

Respectfully submitted,

/Rudolf O. Siegesmund/

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: <b>Dolph</b>	§	
	§	Group Art Unit: <b>2621</b>
Serial No.: <b>10/803,631</b>	§	
	§	Examiner: <b>Tekle, Daniel T.</b>
Filed: <b>March 18, 2004</b>	§	
	§	Confirmation No.: <b>5810</b>
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**SUPPLEMENTAL APPEAL BRIEF (37 C.F.R. 41.37)**

No fees are believed to be required for filing this Appeal Brief. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension of time to IBM Corporation Deposit Account No. 09-0447.

### **REAL PARTY IN INTEREST**

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

### **RELATED APPEALS AND INTERFERENCES**

This appeal has no related proceedings or interferences.

## **STATUS OF CLAIMS**

### **A. TOTAL NUMBER OF CLAIMS IN APPLICATION**

The claims in the application are: 23

### **B. STATUS OF ALL THE CLAIMS IN APPLICATION**

Claims canceled: 24-26

Claims withdrawn from consideration but not canceled: None

Claims pending: 1-23

Claims allowed: None

Claims rejected: 1-23

Claims objected to: None

### **C. CLAIMS ON APPEAL**

The claims on appeal are: 1-23

### **STATUS OF AMENDMENTS**

Appellant did not file an Amendment after the Final Rejection dated January 28, 2008. The claims stand as written in the Amendment filed November 9, 2007.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

The following provides a concise explanation of the subject matter defined in each of the separately argued claims involved in the Appeal as required by 37 C.F.R. § 41.37I(1)(v). The features are identified by corresponding references to the specification and drawings where applicable. It should be noted that the citations to passages in the specification and drawings for each feature do not imply that the limitations from the specification and drawings should be read into the corresponding claim element. Rather, this summary is provided for the convenience of the Board.

### **A. CLAIM 1 - INDEPENDENT**

Embodiments of the invention according to claim 1 provide a method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) (FIG. 1, element 95; FIG. 2; and Specification [0015]) comprising:

receiving a television program containing an original marketing from a service provider (Specification [0023]); (*see* FIG. 4, element 204; and Specification [0034]);

storing the television program in the memory; (FIG. 4, element 204; and Specification [0034]);

sending a user ID (Specification [0025]) and a program ID (Specification [0021]) to the service provider (Specification [0023]) to cause a local marketing content (Specification [0016]), based upon the user ID and the program ID, to be sent to the DVR; (FIG. 4, element 206; and Specification [0034]);

determining whether a local marketing content (Specification [0016]) has been received at the DVR; (FIG. 4, element 212; and Specification [0035]);

responsive to the determination that the local marketing content has been received at the DVR, creating a modified marketing (Specification [0018]) by modifying the original marketing with the local marketing content; (FIG. 4, elements 216, 218, and 220; and Specification [0036]); and

displaying the television program with the modified marketing upon a user request. (FIG. 4, element 222; and Specification [0036]).



**B. CLAIM 2 - DEPENDENT**

Embodiments of the invention according to claim 2 provide the method of claim 1 further comprising:

determining whether a message indicating that no local marketing content exists for the television program has been received; (FIG. 4, element 208; and Specification [0035]); and

responsive to the determination that the message indicating that no local marketing content exists for the television program has been received, displaying the television program with the original marketing upon the user request. (FIG. 4, element 210; and Specification [0035]).

**C. CLAIM 3 - DEPENDENT**

Embodiments of the invention according to claim 3 provide the method of claim 2 further comprising:

responsive to the determination that the local marketing content has been received, determining whether the local marketing content is add-on marketing (Specification [0013]); (FIG. 4, element 214; and Specification [0036]); and

responsive to the determination that the local marketing content is add-on marketing, creating the modified marketing by adding the add-on marketing into the television program without modifying the substance of original marketing. (FIG. 4, element 216; and Specification [0036]).

**D. CLAIM 4 - DEPENDENT**

Embodiments of the invention according to claim 4 provide the method of claim 3 further comprising:

responsive to the determination that a local marketing content (Specification [0016]) has been received, determining whether the local marketing content is replacement marketing (Specification [0022]); (FIG. 4, element 214; and Specification [0036]); and

responsive to the determination that the local marketing content is replacement marketing, creating the modified marketing by replacing the original marketing with the replacement marketing. (FIG. 4, element 218; and Specification [0036]).

**E. CLAIM 5- DEPENDENT**

Embodiments of the invention according to claim 5 provide the method of claim 4 further comprising:

responsive to the determination that a local marketing content (Specification [0016]) has been received, determining whether the local marketing content is overlay marketing (Specification [0020]); (FIG. 4, element 214; and Specification [0036]); and

responsive to the determination that the local marketing content is overlay marketing, creating the modified marketing by placing the overlay marketing over the original marketing. (FIG. 4, element 220; and Specification [0036]).

**F. CLAIM 6 - INDEPENDENT**

Embodiments of the invention according to claim 6 provide a method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) (FIG. 1, element 95; FIG. 2; and Specification [0015]) comprising:

receiving a user ID (Specification [0025]) and a program ID (Specification [0021]); (FIG. 5, element 304; and Specification [0037]);

determining the location of a user based on the user ID; (FIG. 5, element 306; and Specification [0037]);

determining whether a local marketing content (Specification [0016]) exists for a television program based on the program ID; (FIG. 5, element 308; and Specification [0037]); and

responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR. (FIG. 5, element 310; and Specification [0037]).

#### **G. CLAIM 8 - DEPENDENT**

Embodiments of the invention according to claim 8 provide the method of claim 7 wherein the location of the user is determined by cross-referencing the user ID with information stored in a user profile. (Specification [0006] and [0037]).

#### **H. CLAIM 12 - INDEPENDENT**

Embodiments of the invention according to claim 12 provide an apparatus for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) (FIG. 1, element 95; FIG. 2; and Specification [0015]) comprising:

- a storage medium (FIG. 2, element 100; and Specification [0027]);

- wherein the storage medium comprises instructions for a processor to perform steps comprising:

- receiving a television program containing an original marketing from a service provider (Specification [0023]); (*see* FIG. 4, element 204; and Specification [0034]);

- storing the television program in the memory; (FIG. 4, element 204; and Specification [0034]);

- sending a user ID (Specification [0025]) and a program ID (Specification [0021]) to the service provider (Specification [0023]) to cause a local marketing content (Specification [0016]), based upon the user ID and the program ID, to be sent to the DVR; (FIG. 4, element 206; and Specification [0034]);

- determining whether a local marketing content (Specification [0016]) has been received; (FIG. 4, element 212; and Specification [0035]);

- responsive to the determination that the local marketing content has been received at the DVR, creating a modified marketing (Specification [0018]) by modifying the original marketing with the local marketing content; (FIG. 4, elements 216, 218, and 220; and Specification [0036]); and

- displaying the television program with the modified marketing upon a user request. (FIG. 4, element 222; and Specification [0036]).

## **I. CLAIM 17 - INDEPENDENT**

Embodiments of the invention according to claim 17 provide an apparatus for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) (FIG. 1, element 95; FIG. 2; and Specification [0015]) comprising:

a storage medium (FIG. 2, element 100; and Specification [0027]);

wherein the storage medium comprises instructions for a processor to perform steps comprising:

receiving a user ID (Specification [0025]) and a program ID (Specification [0021]) from a DVR; (FIG. 5, element 304; and Specification [0037]);

determining the location of a user based on the user ID; (FIG. 5, element 306; and Specification [0037]);

determining whether a local marketing content (Specification [0016]) exists for a television program based on the program ID; (FIG. 5, element 308; and Specification [0037]); and

responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR. (FIG. 5, element 310; and Specification [0037]).

## **J. CLAIM 23 - INDEPENDENT**

Embodiments of the invention according to claim 23 provide an apparatus for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) (FIG. 1, element 95; FIG. 2; and Specification [0015]) comprising:

at the DVR, receiving a television program containing an original marketing from a service provider (Specification [0023]); (*see* FIG. 4, element 204; and Specification [0034]);

at the DVR, storing the television program in the memory; (FIG. 4, element 204; and Specification [0034]);

at the DVR, sending a user ID (Specification [0025]) and a program ID (Specification [0021]) to the service provider (Specification [0023]) to cause the a local marketing content (Specification [0016]), based upon the user ID and the program ID, to be sent to the DVR; (FIG. 4, element 206; and Specification [0034]);

at the service provider, receiving the user ID and the program ID; (FIG. 5, element 304; and Specification [0037]);

at the service provider, determining the location of a user based on the user ID; (FIG. 5, element 306; and Specification [0037]);

at the service provider, determining whether a local marketing content (Specification [0016]) exists for the television program based on the program ID; (FIG. 5, element 308; and Specification [0037]);

at the service provider, responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR; (FIG. 5, element 310; and Specification [0037]);

at the DVR, determining whether the local marketing content has been received; (FIG. 4, element 212; and Specification [0035]);

at the DVR, responsive to the determination that the local marketing content has been received, creating a modified marketing (Specification [0018]) by modifying the original marketing with the local marketing content; (FIG. 4, elements 216, 218, and 220; and Specification [0036]);

at a display connected to the DVR, displaying the television program with the modified marketing upon a user request; (FIG. 4, element 222; and Specification [0036]);

at the DVR, determining whether a message indicating that no local marketing content exists for the television program has been received; (FIG. 4, element 208; and Specification [0035]);

at the DVR, responsive to the determination that the message indicating that no local marketing content exists for the television program has been received, displaying the television program with the original marketing upon the user request; (FIG. 4, element 210; and Specification [0035]);

at the DVR, responsive to the determination that the local marketing content has been received, determining whether the local marketing content is add-on marketing (Specification [0013]); (FIG. 4, element 214; and Specification [0036]);

at the DVR, responsive to the determination that the local marketing content is add-on marketing, creating the modified marketing by adding the add-on marketing into the television

program without modifying the substance of original marketing; (FIG. 4, element 216; and Specification [0036]);

at the DVR, responsive to the determination that a local marketing content (Specification [0016]) has been received, determining whether the local marketing content is replacement marketing (Specification [0022]); (FIG. 4, element 214; and Specification [0036]);

at the DVR, responsive to the determination that the local marketing content is replacement marketing, creating the modified marketing by replacing the original marketing with the replacement marketing; (FIG. 4, element 218; and Specification [0036]);

at the DVR, responsive to the determination that a local marketing content (Specification [0016]) has been received, determining whether the local marketing content is overlay marketing (Specification [0020]); (FIG. 4, element 214; and Specification [0036]);

at the DVR, responsive to the determination that the local marketing content is overlay marketing, creating the modified marketing by placing the overlay marketing over the original marketing; (FIG. 4, element 220; and Specification [0036]);

at the service provider, responsive to a determination that the local marketing content does not exist (FIG. 5, element 308; Specification [0038]), sending a message to the DVR indicating that there is not any local marketing content (FIG. 5, element 312; and Specification [0038]); and

wherein, at the service provider, the location of the user is determined by cross-referencing the user ID with information stored in a user profile. (Specification [0006] and [0037]).

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The grounds of rejection to review on appeal are as follows:

### **A. GROUND OF REJECTION 1**

Whether claims 1-23 failed to be anticipated under 35 U.S.C. § 102(e) over U.S. Patent Application Publication No. 2003-0194199 (hereinafter Roth). Final Office Action pp. 3–6

## **ARGUMENT**

### **A. GROUND OF REJECTION 1 (Claims 1-23)**

Claims 1-23 were rejected under 35 U.S.C. § 102(e) over U.S. Patent Application Publication No. 2003-0194199 (hereinafter Roth). Final Office Action pp. 3–6. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

#### **1. Claim 1**

Claim 1 recites “a user ID and a program ID.” The cited art is silent to these limitations, as previously shown by Appellant. Amendment filed Nov. 11, 2007, p.11. In response, the Examiner alleges these limitations are inherent to the cited art. Final Office Action p.2. Specifically, the Examiner relies on a quotation (without citation) stating “It is inherent to have [a] user ID as well as [a] program ID in order to have access [to] a specific TV set with in the region between the service provider and user.” *Id.* The cited art fails to teach the limitations of “a user ID and a program ID” for at least two reasons.

First, as discussed previously, Roth is silent to any user ID and is silent to any program ID. Amendment filed Nov. 11, 2007, p.11. Appellant reiterates and extends the previous arguments. Roth teaches providing a specific commercial to a downstream system 80 (e.g., at a first terminal of an airport) and providing a different commercial to a second downstream system 80 (e.g., at a second terminal of an airport). Roth [0046]. Roth is silent any user ID and is silent any program ID being used in connection with the first downstream system 80 or with the second downstream system 80. Hence, Roth is silent to a user ID and is silent to a program ID.

Second, “a user ID and a program ID” do not necessarily flow from the teachings of Roth. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The fact that a certain result or



characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

“A user ID and a program ID” do not necessarily flow from the teachings of Roth because even though a form of user ID or program ID may be used with Roth’s system, a user ID and a program ID is not necessary for Roth’s system. Roth teaches upstream 60 providing a specific commercial to a downstream system 80 (e.g., at a first terminal of an airport) and providing a different commercial to a second downstream system 80 (e.g., at a second terminal of an airport). *See* Roth [0046]. Appellant notes that first downstream system 80 and second downstream 80 may be connected to upstream system 60 by separate cables, such that no user ID and no program ID would be required to send different commercials to first downstream system 80 and to second downstream 80. Hence, the limitations of “a user ID and a program ID” do not necessarily flow from the teachings of Roth.

Claim 1 also recites “sending a user ID and a program ID to the service provider to cause a local marketing content, based upon the user ID and the program ID, to be sent to the DVR.” Appellant previously argued the cited art fails to teach “sending a user ID and a program ID to the service provider.” Amendment filed Nov. 11, 2007, p.11. The Examiner did not respond to Appellant’s argument and apparently interprets Roth’s broadcast source—i.e., a local broadcasting station or a national broadcaster—as meeting the claim’s “a service provider.” *See* Final Office Action p.3 (citing to Roth [0046]-[0048]). Also, the Examiner appears to interpret Roth’s television broadcast signal as inherently comprising the claim’s user ID and program ID, with which Appellant disagrees, as discussed above. Appellant hereby reiterates and extends the previous arguments.

First, Roth fails to teach “sending a user ID and a program ID to the service provider” because Roth is silent to sending any user ID or program ID to its broadcast source. The Examiner apparently interprets Roth’s broadcast source—i.e., a local broadcasting station or a national broadcaster—as meeting the claim’s “a service provider.” *See* Final Office Action p.3 (citing to Roth [0046]-[0048]). Roth teaches sending a television broadcast signal from upstream system 60 to downstream systems 80 (Roth [0046]-[0047]) and Roth also teaches receiving television broadcast signal from a broadcast source (Roth [0022]). However, Roth is silent to

sending any signals to its broadcast source. Hence, the cited art fails to teach “sending a user ID and a program ID to the service provider.”

Second, Roth fails to teach “to cause a local marketing content, based upon the user ID and the program ID, to be sent to the DVR” because the commercials sent to Roth’s downstream system 80 are not based on a user ID and a program ID. The Examiner interprets Roth’s commercial as meeting the claim’s “local marketing content,” interprets Roth’s downstream system 80 as meeting the claim’s DVR, and reasons that Roth’s teachings of “determining the commercial that specific television sets within its region or governing TV set in the region” meets the limitations. *See* Final Office Action p.3 (citing to Roth [0046]). Roth teaches providing a specific commercial to a downstream system 80 (e.g., at a first terminal of an airport) and providing a different commercial to a second downstream system 80 at a different location (e.g., at a second terminal of an airport). Roth [0046]. In other words, Roth at best teaches its commercial is based upon the location of downstream system 80. Although Roth may teach to cause a commercial, based upon the location of downstream system 80, to be sent to downstream system 80, Roth is silent to its commercial being based upon a user ID and a program ID. Hence, Roth fails to teach “to cause a local marketing content, based upon the user ID and the program ID, to be sent to the DVR.”

Thus, the cited art fails to teach each and every element as set forth in the claim. Therefore, Appellant respectfully requests that the rejection be reversed.

## **2. *Claim 2***

In addition to the features inherited from its base and any intervening claims that are not taught by the cited art, as discussed above, claim 2 also recites “determining whether a message indicating that no local marketing content exists for the television program has been received.” Appellant has previously shown that the cited art fails to teach these limitations. Amendment filed Nov. 9, 2007 p.12. The Examiner did not respond to Appellant’s arguments, which Appellant reiterates below for the convenience of the Board.

The Examiner alleges Roth paragraph [0046] teaches the limitations, yet the Examiner does not state what part of Roth is being interpreted as meeting the claim’s “message.” Final Office Action p.3. Appellant notes the cited portions of Roth are silent to a “message,” much less “a message indicating that no local marketing content exists.” Hence, the cited art fails to

teach “determining whether a message indicating that no local marketing content exists for the television program has been received,” as set forth in the claim.

Thus, the cited art fails to teach each and every element as set forth in the claim. Therefore, Appellant respectfully requests that the rejection be reversed.

### **3. *Claim 3***

In addition to the features inherited from its base and any intervening claims that are not taught by the cited art, as discussed above, claim 3 also recites “determining whether the local marketing content is add-on marketing.” Appellant has previously shown that the cited art fails to teach these limitations. Amendment filed Nov. 9, 2007 p.12. The Examiner did not respond to Appellant’s arguments, which Appellant reiterates below for the convenience of the Board. The Examiner alleges Roth paragraphs [0007] and [0015] teach these limitations stating “[a] local TV station can determine and substitute a local commercial signal in place of a national commercial signal.” Final Office Action p.4. The Examiner interprets Roth’s local commercial signal as meeting the claim’s “local marketing content.” The Examiner does not state which teaching of Roth is being interpreted as meeting the claim’s “add-on marketing.” *Id.* Roth is silent to determining whether it’s local commercial signals are “add-on” commercial signals. Hence, the cited art fails to teach “determining whether the local marketing content is add-on marketing,” as set forth in the claim.

Claim 3 also recites “adding the add-on marketing into the television program without modifying the substance of original marketing.” Appellant has previously shown that the cited art fails to teach these limitations. Amendment filed Nov. 9, 2007 p.13. The Examiner did not respond to Appellant’s arguments, which Appellant reiterates below for the convenience of the Board.

The Examiner alleges Roth paragraphs [0007] and [0015] teach these limitations and, though it is not stated, appears to interpret Roth’s “existing commercial signals” and “alternate commercial signals” as meeting the claim’s “original marketing” and “add-on marketing.” *See* Final Office Action p.4. Roth teaches “local substitution of alternate commercial signals in place of existing commercial signals within a television broadcast signal. *E.g.*, Roth para. [0047]. As such, Roth’s local substitution modifies the existing commercial signal by substituting the original commercial with the alternate commercial. Roth is silent to adding an alternate

commercial without modifying the original commercial. Hence, Roth fails to teach “adding the add-on marketing into the television program without modifying the substance of original marketing,” as set forth in the claim.

Thus, the cited art fails to teach each and every element as set forth in the claim. Therefore, Appellant respectfully requests that the rejection be reversed.

#### **4. Claim 4**

In addition to the features inherited from its base and any intervening claims that are not taught by the cited art, as discussed above, claim 4 also recites “determining whether the local marketing content is replacement marketing.” Appellant has previously shown that the cited art fails to teach these limitations. Amendment filed Nov. 9, 2007 p.13. The Examiner did not respond to Appellant’s arguments, which Appellant reiterates below for the convenience of the Board.

The Examiner appears to interpret Roth’s alternate commercials as meeting the claim’s “local marketing content,” yet does not state which teaching of Roth is being interpreted as meeting the claim’s “replacement marketing.” *See* Final Office Action p.4. The cited portions of Roth are silent to determining whether its alternate commercials are “replacement marketing.” Hence, the cited art fails to teach “determining whether the local marketing content is replacement marketing,” as set forth in the claim.

Thus, the cited art fails to teach each and every element as set forth in the claim. Therefore, Appellant respectfully requests that the rejection be reversed.

#### **5. Claim 5**

In addition to the features inherited from its base and any intervening claims that are not taught by the cited art, as discussed above, claim 5 also recites “determining whether the local marketing content is overlay marketing.” Appellant has previously shown that the cited art fails to teach these limitations. Amendment filed Nov. 9, 2007 p.14. The Examiner did not respond to Appellant’s arguments, which Appellant reiterates below for the convenience of the Board.

The Examiner appears to interpret Roth’s alternate commercials as meeting the claim’s “local marketing content,” yet does not state which teaching of Roth is being interpreted as meeting the claim’s “overlay marketing.” *See* Final Office Action pp. 4-5. The cited portions of

Roth are silent to determining whether its alternate commercials are “overlay marketing.” Hence, the cited art fails to teach “determining whether the local marketing content is overlay marketing,” as set forth in the claim.

Thus, the cited art fails to teach each and every element as set forth in the claim. Therefore, Appellant respectfully requests that the rejection be reversed.

## **6. Claim 6**

Claim 6 recites “a user ID and a program ID.” The cited art is silent to these limitations, as previously shown by Appellant. Amendment filed Nov. 11, 2007, p.14. In response, the Examiner alleges these limitations are inherent to the cited art. Final Office Action p.2. Specifically, the Examiner relies on a quotation (without citation) stating “It is inherent to have [a] user ID as well as [a] program ID in order to have access [to] a specific TV set with in the region between the service provider and user.” *Id.* The cited art fails to teach the limitations of “a user ID and a program ID” for at least two reasons.

First, as discussed previously, Roth is silent to any user ID and is silent to any program ID. Amendment filed Nov. 11, 2007, p.11. Appellant reiterates and extends the previous arguments. Roth teaches providing a specific commercial to a downstream system 80 (e.g., at a first terminal of an airport) and providing a different commercial to a second downstream system 80 (e.g., at a second terminal of an airport). Roth [0046]. Roth is silent any user ID and is silent any program ID being used in connection with the first downstream system 80 or with the second downstream system 80. Hence, Roth is silent to a user ID and is silent to a program ID.

Second, “a user ID and a program ID” do not necessarily flow from the teachings of Roth. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

“A user ID and a program ID” do not necessarily flow from the teachings of Roth because even though a form of user ID or program ID may be used with Roth’s system, a user ID and a

program ID is not necessary for Roth's system. Roth teaches upstream 60 providing a specific commercial to a downstream system 80 (e.g., at a first terminal of an airport) and providing a different commercial to a second downstream system 80 (e.g., at a second terminal of an airport). *See* Roth [0046]. Appellant notes that first downstream system 80 and second downstream 80 may be connected to upstream system 60 by separate cables, such that no user ID and no program ID would be required to send different commercials to first downstream system 80 and to second downstream 80. Hence, the limitations of "a user ID and a program ID" do not necessarily flow from the teachings of Roth.

Claim 6 also recites "determining the location of a user based on the user ID." The cited art fails to teach these limitations. The Examiner alleges Roth paragraph [0046] teaches these limitations. Final Office Action p.5. Roth, at [0046], teaches providing a specific commercial to a downstream system 80 (e.g., at a first terminal of an airport) and providing a different commercial to a second downstream system 80 (e.g., at a second terminal of an airport). The cited portions of Roth are silent to determining a location of a user of downstream system 80. Hence, Roth fails to teach "determining the location of a user," as set forth in the claim.

Claim 6 also recites "determining whether a local marketing content exists for the television program based on the program ID." The Examiner alleges Roth [0046] teaches these limitations. Final Office Action p.5. Specifically, the Examiner alleges Roth's teachings of providing different commercials to different downstream systems 80 meets the limitations; interprets Roth's program signal as meeting the claim's "television program"; and interprets Roth's program signal as inherently meeting the claim's "program ID." *See* Final Office Action pp. 2 & 5. Roth, at [0046], teaches providing a specific commercial to a downstream system 80 (e.g., at a first terminal of an airport) and providing a different commercial to a second downstream system 80 (e.g., at a second terminal of an airport). Roth is silent to basing a determination of whether a commercial exists on the program signal. Put another way, even if Roth taught determining whether a commercial exists for a downstream system 80 based upon the location of downstream system 80, *arguendo*, Roth still fails to teach determining whether a commercial exists for a program signal based upon the program signal. Hence, Roth fails to teach "determining whether a local marketing content exists for the television program based on the program ID."

Thus, the cited art fails to teach each and every element as set forth in the claim. Therefore, Appellant respectfully requests that the rejection be reversed.

**7.     *Claim 8***

In addition to the features inherited from its base and any intervening claims that are not taught by the cited art, as discussed above, claim 8 also recites “a user profile.” The cited art is silent to these limitations, as previously shown by Appellant. Amendment filed Nov. 11, 2007, p.15. The Examiner did not address Appellant’s argument, as such, Appellant’s argument still stands and is reiterated here for the convenience of the Board.

Roth fails to teach “a user profile,” as set forth in the claim at least because the cited portions of Roth are silent to a user profile. The Examiner does not state which, if any, teaching of the cited portion of Roth is being interpreted as meeting the claim’s “user profile.” The cited portions of Roth are silent to a “profile,” much less a “user profile.” Hence, the cited art fails to teach “a user profile,” as set forth in the claim.

Thus, the cited art fails to teach each and every element as set forth in the claim. Therefore, Appellant respectfully requests that the rejection be reversed.

**8.     *Claims 7 and 9-11***

Claims 7 and 9-11 each depend from and inherit all the limitations of claim 6. As discussed above, claim 6 contains features and limitations that are not taught by the cited art. Thus, claims 7 and 9-11 each contain features and limitations that are not taught by the cited art. Therefore, Appellant respectfully requests that the rejection be reversed.

**9. *Claim 12 and Claims 13-22***

Claims 12-22 comprise features and limitations similar to claims 1-11 respectively. As discussed above, claims 1-11 comprise features and limitations that are not taught by the cited art. Thus, claims 12-22 comprise features and limitations that are not taught by the cited art. Therefore, Appellant respectfully requests that the rejection be reversed.

**10. *Claim 23***

In addition to the features and limitations that are similar to features limitations of claims 1-11 that are not taught by the cited art, as discussed above, claim 23 comprises additional subject matter. Appellant hereby argues the addition subject matter of claim 23.

Claim 23 recites “at the DVR, sending a user ID and a program ID to the service provider to cause the a local marketing content, based upon the user ID and the program ID, to be sent to the DVR.” The Examiner alleges Roth’s downstream system 80 meets the claim’s “DVR”; alleges Roth’s broadcast source—i.e., a local broadcasting station or a national broadcaster—meets the claim’s “service provider”; and alleges that a user ID and a program ID are inherent to Roth’s system. Final Office Action pp.2-3

The cited art fails to teach “at the DVR, sending a user ID and a program ID to the service provider” at least because Roth is silent to its downstream system 80 sending a user ID and a program ID to Roth’s broadcast source. Roth teaches sending a television broadcast signal from upstream system 60 to downstream systems 80 (Roth [0046]-[0047]) and Roth also teaches receiving television broadcast signal from a broadcast source at an upstream device (Roth [0022]). However, Roth is silent its downstream device 80 sending any form of user ID or program ID to Roth’s broadcast source. Hence, the cited art fails to teach “at the DVR, sending a user ID and a program ID to the service provider,” as set forth in the claim.

Claim 23 also recites “at the service provider, receiving the user ID and the program ID.” The Examiner alleges Roth’s broadcast source—i.e., a local broadcasting station or a national broadcaster—meets the claim’s “service provider,” and alleges that a user ID and a program ID are inherent to Roth’s system. Final Office Action pp.2-3

The cited art fails to teach “at the service provider, receiving the user ID and the program ID” at least because Roth is silent to its broadcast source receiving a user ID and a program ID. Roth teaches sending a television broadcast signal from upstream system 60 to downstream



systems 80 (Roth [0046]-[0047]) and Roth also teaches receiving television broadcast signal from a broadcast source at an upstream device (Roth [0022]). However, Roth is silent its broadcast source receiving any form of user ID or program ID. Hence, the cited art fails to teach “at the service provider, receiving the user ID and the program ID,” as set forth in the claim.

Claim 23 also recites “at the service provider, responsive to a determination that the local marketing content does not exist, sending a message to the DVR indicating that there is not any local marketing content.” The Examiner alleges Roth’s broadcast source—i.e., a local broadcasting station or a national broadcaster—meets the claim’s “service provider,” and alleges Roth’s commercials meet the claim’s “local marketing content”. Final Office Action p.5 (rejecting similar features from claim 7).

The cited art fails to teach “at the service provider, ... sending a message to the DVR indicating that there is not any local marketing content” at least because Roth is silent to its broadcast source sending a message indicating that there are no commercials. Roth teaches sending a television broadcast signal from upstream system 60 to downstream systems 80 (Roth [0046]-[0047]) and Roth also teaches receiving television broadcast signal from a broadcast source at an upstream device (Roth [0022]). However, Roth is silent to its broadcast source sending a message to a downstream device 80 that there are no commercials. Hence, the cited art fails to teach “at the service provider, ... sending a message to the DVR indicating that there is not any local marketing content,” as set forth in the claim.

**B. CONCLUSION**

As shown above, the Examiner has failed to state valid rejections against any of the claims. Therefore, Appellant requests that the Board of Patent Appeals and Interferences reverse the rejections. Additionally, Appellant requests that the Board direct the Examiner to allow the claims.

Date: November 17, 2008

Respectfully submitted,

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## **CLAIMS APPENDIX**

The text of the claims involved in the appeal is as follows:

1. A method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising:

receiving a television program containing an original marketing from a service provider;

storing the television program in the memory;

sending a user ID and a program ID to the service provider to cause a local marketing content, based upon the user ID and the program ID, to be sent to the DVR;

determining whether a local marketing content has been received at the DVR;

responsive to the determination that the local marketing content has been received at the DVR, creating a modified marketing by modifying the original marketing with the local marketing content; and

displaying the television program with the modified marketing upon a user request.

2. The method of claim 1 further comprising:

determining whether a message indicating that no local marketing content exists for the television program has been received; and

responsive to the determination that the message indicating that no local marketing content exists for the television program has been received, displaying the television program with the original marketing upon the user request.

3. The method of claim 2 further comprising:

responsive to the determination that the local marketing content has been received,  
determining whether the local marketing content is add-on marketing; and

responsive to the determination that the local marketing content is add-on marketing,  
creating the modified marketing by adding the add-on marketing into the television program  
without modifying the substance of original marketing.

4. The method of claim 3 further comprising:

responsive to the determination that a local marketing content has been received,  
determining whether the local marketing content is replacement marketing; and

responsive to the determination that the local marketing content is replacement  
marketing, creating the modified marketing by replacing the original marketing with the  
replacement marketing.

5. The method of claim 4 further comprising:

responsive to the determination that a local marketing content has been received,  
determining whether the local marketing content is overlay marketing; and

responsive to the determination that the local marketing content is overlay marketing,  
creating the modified marketing by placing the overlay marketing over the original marketing.

6. A method for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising:

receiving a user ID and a program ID;

determining the location of a user based on the user ID;

determining whether a local marketing content exists for a television program based on the program ID; and

responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR.

7. The method of claim 6 further comprising: responsive to the determination that the local marketing content does not exist, sending a message to the DVR indicating that there is not any local marketing content.

8. The method of claim 7 wherein the location of the user is determined by cross-referencing the user ID with information stored in a user profile.

9. The method of claim 8 wherein the local marketing content is add-on marketing.

10. The method of claim 8 wherein the local marketing content is replacement marketing.

11. The method of claim 8 wherein the local marketing content is overlay marketing.

12. An apparatus for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising:

a storage medium;

wherein the storage medium comprises instructions for a processor to perform steps comprising:

receiving a television program containing an original marketing from a service provider;

storing the television program in the memory;

sending a user ID and a program ID to the service provider to cause a local marketing content, based upon the user ID and the program ID, to be sent to the DVR;

determining whether a local marketing content has been received;

responsive to the determination that the local marketing content has been received at the DVR, creating a modified marketing by modifying the original marketing with the local marketing content; and

displaying the television program with the modified marketing upon a user request.

13. The apparatus of claim 12 further comprising:

determining whether a message indicating that no local marketing content exists for the television program has been received; and

responsive to the determination that the message indicating that no local marketing content exists for the television program has been received, displaying the television program with the original marketing upon the user request.

14. The apparatus of claim 12 further comprising:

responsive to the determination that the local marketing content has been received,  
determining whether the local marketing content is add-on marketing; and

responsive to the determination that the local marketing content is add-on marketing,  
creating the modified marketing by adding the add-on marketing into the television program  
without modifying the substance of original marketing.

15. The apparatus of claim 12 further comprising:

responsive to the determination that a local marketing content has been received,  
determining whether the local marketing content is replacement marketing; and

responsive to the determination that the local marketing content is replacement  
marketing, creating the modified marketing by replacing the original marketing with the  
replacement marketing.

16. The apparatus of claim 12 further comprising:

responsive to the determination that a local marketing content has been received,  
determining whether the local marketing content is overlay marketing; and

responsive to the determination that the local marketing content is overlay marketing,  
creating the modified marketing by placing the overlay marketing over the original marketing.

17. An apparatus for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising:

a storage medium;

wherein the storage medium comprises instructions for a processor to perform steps comprising:

receiving a user ID and a program ID from a DVR;

determining the location of a user based on the user ID;

determining whether a local marketing content exists for a television program based on the program ID; and

responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR.

18. The apparatus of claim 17 further comprising: responsive to the determination that the local marketing content does not exist, sending a message to the DVR indicating that there is not any local marketing content.

19. The apparatus of claim 17 wherein the location of the user is determined by cross-referencing the user ID with information stored in a user profile.

20. The apparatus of claim 17 wherein the local marketing content is add-on marketing.

21. The apparatus of claim 17 wherein the local marketing content is replacement marketing.



22. The apparatus of claim 17 wherein the local marketing content is overlay marketing.

23. An apparatus for modifying a marketing stored within a memory of a Digital Video Recorder (DVR) comprising:

at the DVR, receiving a television program containing an original marketing from a service provider;

at the DVR, storing the television program in the memory;

at the DVR, sending a user ID and a program ID to the service provider to cause the a local marketing content, based upon the user ID and the program ID, to be sent to the DVR;

at the service provider, receiving the user ID and the program ID;

at the service provider, determining the location of a user based on the user ID;

at the service provider, determining whether a local marketing content exists for the television program based on the program ID;

at the service provider, responsive to the determination that the local marketing content does exist, sending the local marketing content to the DVR;

at the DVR, determining whether the local marketing content has been received;

at the DVR, responsive to the determination that the local marketing content has been received, creating a modified marketing by modifying the original marketing with the local marketing content;

at a display connected to the DVR, displaying the television program with the modified marketing upon a user request;

at the DVR, determining whether a message indicating that no local marketing content exists for the television program has been received;

at the DVR, responsive to the determination that the message indicating that no local marketing content exists for the television program has been received, displaying the television program with the original marketing upon the user request;

at the DVR, responsive to the determination that the local marketing content has been received, determining whether the local marketing content is add-on marketing;

at the DVR, responsive to the determination that the local marketing content is add-on marketing, creating the modified marketing by adding the add-on marketing into the television program without modifying the substance of original marketing;

at the DVR, responsive to the determination that a local marketing content has been received, determining whether the local marketing content is replacement marketing;

at the DVR, responsive to the determination that the local marketing content is replacement marketing, creating the modified marketing by replacing the original marketing with the replacement marketing;

at the DVR, responsive to the determination that a local marketing content has been received, determining whether the local marketing content is overlay marketing;

at the DVR, responsive to the determination that the local marketing content is overlay marketing, creating the modified marketing by placing the overlay marketing over the original marketing;

at the service provider, responsive to a determination that the local marketing content does not exist, sending a message to the DVR indicating that there is not any local marketing content; and

wherein, at the service provider, the location of the user is determined by cross-referencing the user ID with information stored in a user profile.

## **EVIDENCE APPENDIX**

This appeal brief presents no additional evidence.

## **RELATED PROCEEDINGS APPENDIX**

This appeal has no related proceedings.